



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/091,201      | 03/05/2002  | Yacoob Tabani        | 220005              | 6365             |

7590 06/12/2003

Birgit E. Morris  
16 Indian Head Road  
Morristown, NJ 07960

EXAMINER

CHAUDHRY, SAEED T

ART UNIT PAPER NUMBER

1746

DATE MAILED: 06/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|  |                  |                        |
|--|------------------|------------------------|
| <b>Office Action Summary</b>   | Application No.  | Applicant(s)           |
|  | 10/091,201       | TABANI ET AL. <i>9</i> |
| <b>Period for Reply</b>  | Examiner         | Art Unit               |
|  | Saeed T Chaudhry | 1746                   |
| <i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>   |                  |                        |
| <b>A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.</b>   |                  |                        |
| <ul style="list-style-type: none"> <li>- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.</li> <li>- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.</li> <li>- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.</li> <li>- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).</li> <li>- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).</li> </ul> |                  |                        |
| <b>Status</b>  |                  |                        |
| 1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>17 March 2003</u> .  |                  |                        |
| 2a) <input type="checkbox"/> This action is FINAL.                            2b) <input type="checkbox"/> This action is non-final.   |                  |                        |
| 3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.  |                  |                        |
| <b>Disposition of Claims</b>   |                  |                        |
| 4) <input checked="" type="checkbox"/> Claim(s) <u>25-93</u> is/are pending in the application.  |                  |                        |
| 4a) Of the above claim(s) _____ is/are withdrawn from consideration.   |                  |                        |
| 5) <input type="checkbox"/> Claim(s) _____ is/are allowed.   |                  |                        |
| 6) <input type="checkbox"/> Claim(s) _____ is/are rejected.  |                  |                        |
| 7) <input type="checkbox"/> Claim(s) _____ is/are objected to.   |                  |                        |
| 8) <input checked="" type="checkbox"/> Claim(s) <u>25-93</u> are subject to restriction and/or election requirement.   |                  |                        |
| <b>Application Papers</b>  |                  |                        |
| 9) <input type="checkbox"/> The specification is objected to by the Examiner.  |                  |                        |
| 10) <input type="checkbox"/> The drawing(s) filed on _____ is/are: a) <input type="checkbox"/> accepted or b) <input type="checkbox"/> objected to by the Examiner.  |                  |                        |
| Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  |                  |                        |
| 11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved by the Examiner.  |                  |                        |
| If approved, corrected drawings are required in reply to this Office action.   |                  |                        |
| 12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.   |                  |                        |
| <b>Priority under 35 U.S.C. §§ 119 and 120</b>   |                  |                        |
| 13) <input type="checkbox"/> Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).   |                  |                        |
| a) <input type="checkbox"/> All    b) <input type="checkbox"/> Some * c) <input type="checkbox"/> None of:   |                  |                        |
| 1. <input type="checkbox"/> Certified copies of the priority documents have been received.   |                  |                        |
| 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____.  |                  |                        |
| 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).   |                  |                        |
| * See the attached detailed Office action for a list of the certified copies not received.   |                  |                        |
| 14) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  |                  |                        |
| a) <input type="checkbox"/> The translation of the foreign language provisional application has been received.   |                  |                        |
| 15) <input type="checkbox"/> Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.  |                  |                        |
| <b>Attachment(s)</b>   |                  |                        |
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   |                  |                        |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   |                  |                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.  |                  |                        |
| 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____.  |                  |                        |
| 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |                  |                        |
| 6) <input type="checkbox"/> Other: _____.  |                  |                        |

**Election/Restriction**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I: Claims 25-34, drawn to a method for removing contaminant from a hollow tubing with a two phase flow, classified in Class 134, subclass 22.12.

Group II: Claims 35-76, drawn to a method of cleaning a hemodialyzer having pore, lumens, undercap and hollow fiber membrane by back-flushing, classified in Class 134, subclass 36.

Group III: Claims 77-87, drawn to a method of removing blood proteins from a hemodialyzer by a cleaning solution having a pH at least 7.0, classified in Class 422, subclass 1.

Group IV: Claims 88-93, drawn to An apparatus comprises a two phase tank having air inlet and an inlet for a flushing solution and an inlet for a sterilant, classified in Class 134, subclass 166R.

The inventions are distinct, each from the other because of the following reasons:

Inventions (I, II, III) and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (M.P.E.P. § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as tank without an inlet for a liquid sterilant or the apparatus as claimed can be used to practice another and materially different process such as mixing liquid in the tank or introducing air in the liquid for increasing air concentration in the liquid.

Inventions I, II and III are different processes and they have different modes of operations, wherein Group I require to remove contaminants from a hollow tubing with two phase flow and do not require backflushing hollow fiber or with a solution having pH

7; wherein Group II requires backflushing hollow fibers with solution from the dialysate side and gas from lumen side and does not require two phase or solution of pH 7 and wherein Group III requires cleaning with a solution having a pH 7 and does not require two phase flow or backflushing from dialysate side with solution and gas from lumen side.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, have acquired a separate status in the art because of their recognized divergent subject matter, the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

A telephone call was made to Ms. Birgit E. Morris on June 5, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

### **Joint Inventors**

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

***Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saeed T. Chaudhry whose telephone***

Art Unit: 1746

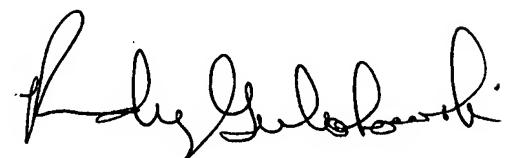
**number is (703) 308-3319. The examiner can normally be reached on Monday-Friday from 9:30 A.M. to 5:00 P.M.**

**If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Gulakowski Randy, can be reached on (703)-308-4333. The fax phone number for this Group is (703)-305-7719.**

**When filing a FAX in Gp 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communication with the PTO that are for entry into the file of the application. This will expedite processing of your papers.**

**Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.**

**Saeed T. Chaudhry**  
**June 5, 2003**



RANDY GULAKOWSKI  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700